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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,236	08/14/2006	Tatsuo Ito	294372US2PCT	6963
22850 7590 04/11/2012 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER RUST, ERIC A				
ART UNIT 2625		PAPER NUMBER		
NOTIFICATION DATE 04/11/2012		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/589,236

Applicant(s)

ITO ET AL.

Examiner

ERIC A. RUST

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 30-33 and 63-70 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 30-33 and 63-70 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-GB08)
- Paper No(s)/Mail Date ____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. In the Amendment filed December 09, 2011, Applicants amended claims 30-33 and 63-70. Claims 30-33 and 63-70 are currently pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 63-66 and 70 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0011633 A1 to Conley et al. (hereinafter, Conley). Conley was cited in the Notice of References Cited dated March 16, 2010.

In regard to claims 63, 66, and 70, Conley discloses a system, comprising:
an image forming apparatus (**Conley, Fig. 3, MFP**); and
an external apparatus connected to the image forming apparatus through a network (**Conley, Fig. 3, PC**),
the image forming apparatus configured to include at least one of hardware resources of a scanner and a plotter (**Conley, [0038], MFP copier**);

a request part configured to send a request of a screen for using an application, which is implemented in the external apparatus and executes an image forming process using the at least one hardware resource (**Conley, [0038], 1-11**);

a display part configured to display the screen for using the application at the display part, the screen sent from the external apparatus in response to the request sent by the request part (**Conley, [0038], 6-9**);

an instruction request sending part configured to send an instruction request for executing the image forming process to the application implemented in the external apparatus, based on an operation of a user to the screen displayed at the display part (**Conley, [0038], 1-8, enterprise application**);

an instruction receiving part configured to receive an execution instruction which is sent from the application in response to the instruction request sent by the instruction request sending part (**Conley, [0038], 13-17, back to MFP to initiate scanner**); and

an execution part configured to execute the image forming process in response to the execution instruction received by the instruction receiving part, by using the at least one hardware resource (**Conley, [0038], 13-17, back to MFP to initiate scanner**),

the external processing apparatus configured to include the application including

a screen sending part configured to send the screen to the image forming apparatus in response to the request sent from the request part (**Conley, [0038], 1-11**);
and

an execution instruction sending part configured to send the execution instruction for executing the image forming process using the at least one hardware resource to the image forming apparatus, in response to the instruction request sent from the instruction request sending part (**Conley, [0038], 13-17**).

In regard to claim 64, which depends from claim 63, Conley disclose wherein execution instruction sending part of the external apparatus sends a request of a screen update instruction to the instruction receiving part of the image forming apparatus (**Conley, [0038], 1-19**); and

the request part of the image forming apparatus sends the screen update instruction to the screen sending part of the external apparatus based on the request of the screen update instruction sent from the execution instruction sending part of the external apparatus (**Conley, [0038], 1-19**).

In regard to claim 65, which depends from claim 63, Conley disclose wherein a screen flow control part of the external apparatus generates the screen based on the request (**Conley, [0038], 1-19**).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained **though** the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conley in view of U.S. Patent Application Publication No. 2004/0160630 A1 to Iriyama et al. (hereinafter, Iriyama). Iriyama was cited in the Notice of References Cited dated October 14, 2019.

In regard to claim 67, Conley discloses a system (**Conley, Fig. 3**), comprising:
an image forming apparatus for forming an image by using a scanner (**Conley, Fig. 3, MFP**); and
an external processing apparatus, wherein the image forming apparatus and the external processing apparatus are connected through a network (**Conley, Fig. 3, PC**);
the image forming apparatus including
a request part configured to send a request of a screen for using an application, which is implemented in the external apparatus (**Conley, [0038], 1-11**);
a display part configured to display the screen for using the application at the display part, the screen sent from the external apparatus in response to the request sent by the request part (**Conley, [0038], 6-9**); and
an instruction request sending part configured to send an instruction request for executing the image forming process to the application implemented in the external

apparatus, based on an operation of a user to the screen displayed at the display part
(**Conley, [0038], 1-8, enterprise application**),

the external processing apparatus configured to include the application including
a screen sending part configured to send the screen to the first image forming
apparatus in response to the request sent from the request part (**Conley, [0038], 1-11**);
and

an execution instruction sending part configured to send the execution instruction
for executing the image forming process using the plotter to the image forming
apparatus, in response to the instruction request sent from the instruction request
sending part (**Conley, [0038], 13-17, back to MFP to initiate scanner**).

Conley does not disclose a second image forming apparatus for forming an
image by using a plotter, the second image forming apparatus connected to the image
forming apparatus and the external processing apparatus via a network, the first image
forming apparatus executing an image forming process using the second image forming
apparatus the second image forming apparatus including an instruction receiving part
configured to receive an execution instruction which is sent from the application in
response to the instruction request sent by the instruction request sending part; and an
execution part configured to execute the image forming process in response to the
execution instruction received by the instruction receiving part, by using the plotter, and
the external apparatus including an execution instruction sending part configured to
send the execution instruction for executing the second image forming process using

the plotter to the image forming apparatus, in response to the instruction request sent from the instruction request sending part.

However, while the missing parts in Conley seem detailed, it is essentially a second image processing apparatus connected to the image processing apparatus and the external apparatus, wherein the second image processing apparatus communicates with both the image processing apparatus and the external processing apparatus.

Moreover, Conley discloses a second image forming apparatus for forming an image by using a plotter, the second image forming apparatus connected to the image forming apparatus and the external processing apparatus via a network, the first image forming apparatus executing an image forming process using the second image forming apparatus (**Iriyama, Fig. 1, [0050] – [0052]**)

That is, Iriyama discloses a second image processing apparatus connected to the image processing apparatus and the external apparatus, wherein the second image processing apparatus communicates with both the image processing apparatus and the external processing apparatus (**Iriyama, Fig. 1, [0050] – [0052]**).

Accordingly, the combination of Iriyama and Conley would disclose the second image forming apparatus including an instruction receiving part configured to receive an execution instruction which is sent from the application in response to the instruction request sent by the instruction request sending part; and an execution part configured to execute the image forming process in response to the execution instruction received by the instruction receiving part, by using the plotter, and the external apparatus including an execution instruction sending part configured to send the execution instruction for

executing the second image forming process using the plotter to the image forming apparatus, in response to the instruction request sent from the instruction request sending part (**Iriyama, Fig. 1, [0050] – [0052] and Conley, [0038]**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Iriyama with the teachings of Conley so that various image processing functions are provided for the user by the user does not take a lot of troubles in finding a desired function. (**Iriyama, [0016]**).

In regard to claim 68, which depends from claim 67, Conley disclose wherein execution instruction sending part of the external apparatus sends a request of a screen update instruction to the instruction receiving part of the image forming apparatus (**Conley, [0038], 1-19**); and

the request part of the image forming apparatus sends the screen update instruction to the screen sending part of the external apparatus based on the request of the screen update instruction sent from the execution instruction sending part of the external apparatus (**Conley, [0038], 1-19**).

In regard to claim 69, which depends from claim 67, Conley disclose wherein a screen flow control part of the external apparatus generates the screen based on the request (**Conley, [0038], 1-19**).

6. Claims 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conley in view of U.S. Patent Application Publication No. 2004/0239975 A1 to Kawaura et al. (hereinafter, Kawaura). Kawaura was cited in the IDS filed by Applicants on June 04, 2008.

In regard to claim 30, which depends from claim 63, Conley does not disclose wherein, when the image forming apparatus and the external apparatus are in an offline state, the image forming apparatus reads out a file for building up the application from a storage area included in the image forming apparatus, builds up the application in the image forming apparatus, and controls at least one of the hardware resources when a request is made to the application built in the image forming apparatus.

Kawaura, however, discloses wherein, when the image forming apparatus and the external apparatus are in an offline state, the image forming apparatus reads out a file for building up the application from a storage area included in the image forming apparatus, builds up the application in the image forming apparatus, and controls at least one of the hardware resources when a request is made to the application built in the image forming apparatus (**Kawaura, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kawaura with the teachings of Conley in order to improve the reliability of an update program (**Kawaura, [0019], lines 5-7**).

In regard to claim 31, which depends from claim 30, Kawaura discloses wherein, while the image forming apparatus and the external apparatus are in an online state, a file for building up the application transferred from the external apparatus to the storage area (**Kawaura, Abstract**).

In regard to claim 32, which depends from claim 63, Conley does not disclose discloses wherein while the image forming apparatus and the external apparatus are in an offline state, at least a part of the screen is transferred from the external apparatus to a storage area, and at least the part of the screen is read out from the storage area.

Kawaura, however, discloses wherein while the image forming apparatus and the external apparatus are in an offline state, at least a part of the screen is transferred from the external apparatus to a storage area, and at least the part of the screen is read out from the storage area (**Kawaura, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kawaura with the teachings of Conley in order to improve the reliability of an update program (**Kawaura, [0019], lines 5-7**).

In regard to claim 33, which depends from claim 30, Conley does not disclose wherein while the image forming apparatus and the external apparatus are in an online state, at least one of the hardware resources is controlled when a request is made to the external apparatus, and, while the image forming apparatus and the external apparatus are in the offline state, the at least one of the hardware resources is

controlled when a request is made to the controlling part built in the image forming apparatus.

Kawaura, however, discloses wherein while the image forming apparatus and the external apparatus are in an offline state, at least a part of the screen is transferred from the external apparatus to a storage area, and at least the part of the screen is read out from the storage area (**Kawaura, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kawaura with the teachings of Conley in order to improve the reliability of an update program (**Kawaura, [0019], lines 5-7**).

Moreover, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kawaura and Conley so that while the image handling apparatus and the external processing apparatus are in an online state, the image formation unit is controlled when a request is made to the controlling part built in the external processing apparatus, and while the image handling apparatus and the external processing apparatus are in an offline state, the image formation unit is controlled when a request is made to the controlling part built in the image handling apparatus in order to ensure that data processing is still completed even though the external processing apparatus is in an offline state.

Response to Arguments

7. Applicants' arguments with respect to claims 30-33 and 63-70 have been considered but are not persuasive.

In regard to Applicants arguments with respect to the claim amendment,

Applicants argue that the claims have been amended and that Conley does not disclose the amended claims. See Amendment, pg. 14.

The Examiner notes that the claims are newly added and have not been rejected or considered as a whole as of this Action. Moreover, Applicants' arguments, while appearing to be a bonafide response, are not specific enough in regard to Conley to allow for the Examiner to answers them any more than has already been presented above in the current rejection.

Conclusion

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-270-4380.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC A. RUST/

Examiner, Art Unit 2625

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/BENNY Q TIEU/

Supervisory Patent Examiner, Art Unit 2625